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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,080	07/25/2003	Joachim Wolf	331.1048	3127
23280	7590	04/21/2005	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018				PICKARD, ALISON K
ART UNIT		PAPER NUMBER		
3676				

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/627,080	WOLF ET AL.	
	Examiner Alison K. Pickard	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 and 6-12 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 1-3 and 7-12 is/are rejected.
 7) Claim(s) 6 is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Devers.

Baker discloses an axle boot comprising a joint housing 16 having plural radial recesses 16b and a bellows 12. The bellows is made of TPE and has an integral connecting collar 15 including a plurality of indentations projecting radially inward and adapted to recesses 16b (see Fig. 2 and col. 3, lines 62-65). A plurality of compensating pieces 22 is attached to an outer surface of the collar to form a cylindrical outer circumference for a clamp 23. The pieces are all connected and include ring sections (near 22) to connect adjacent pieces. The projecting portion of the pieces has a length corresponding to the recess.

Baker does not disclose ring sections wherein at least one ring section is elastically deformable, that the pieces are made of more than one material, or that the pieces have a web. Devers teaches an axle boot having a joint housing and bellows. Devers teaches a plurality of compensating pieces with the bellows. The pieces are connected as a single piece component having ring sections (near 32), wherein at least one is elastically deformable (see col. 4, line 12), which allows the component to be installed. Devers also teaches the compensating pieces include more than one material (i.e. insert 44 is a harder material than the rest of element 40). The pieces

are a hollow (air-filled) body having flexible walls/ webs (e.g. Fig. 7). Devers teaches that this compensating component provides a more uniform stiffness and compression, thus providing a more uniform sealing and clamping force. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the compensating component of Baker with component taught by Devers to provide a more uniform sealing and clamping force.

Allowable Subject Matter

3. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant's arguments filed 1-7-05 have been fully considered but they are not persuasive.

Regarding Applicant's argument that the combination of Baker and Devers does not teach the feature of at least one ring section that is deformable sufficient to enable the component to expand to a circumference larger than the outer circumference of the connecting collar, the examiner disagrees. As stated above, Baker discloses plural compensating pieces 22 connected to one another by plural ring sections to form a single piece component. This component surrounds the outer circumference of the collar 15 of a bellows 12. Devers teaches an improved component. The component has plural compensating pieces connected to one another by plural ring sections to form a single piece component. Since the component is an integral, one-piece construction, Devers teaches making the component pliable so it can be installed in place. In

other words, Devers teaches making the component pliable so that it can fit around the component on which it is to be seated.

In response to applicant's argument that the component of Devers fits inside the boot and therefore would not be pliable enough to fit over the boot, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Baker already teaches that the component sits on the boot (rather than inside the boot). Devers teaches making the component an integral, one-piece unit (as well as the other features of the compensating pieces) to provide a more uniform sealing and clamping force. In making the unit one-piece, Devers teaches making it pliable for installation. Using the teachings of Devers, the component of Baker would be modified such that it is an integral, one-piece unit that is pliable enough to fit around the component on which it is to be seated, i.e. the boot. Thus the ring sections are "elastically deformable sufficient to enable the single piece component to expand to a circumference larger than the outer circumference of the connecting collar".

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3676

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 571-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alison K. Pickard
Primary Examiner
Art Unit 3676

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